

REMARKS

Responsive to the communication mailed on November 12, 2003, Applicants provide the following remarks in an effort to address the issues noted by the Examiner and to more particularly point out and distinguish their invention. Reconsideration and reexamination are, therefore, respectfully requested.

Status of the Claims

Claims 5-6 and claims 9-20 are remain pending in the application without further amendment.

Rejections under 35 USC § 103(a)

Claims 5, 6, 9-11, 14-17 and 20 stand rejected under 35 USC § 103(a) as being unpatentable over *Gossiau* (US 1,972,441) in view of *Nishimura et al.* (US 4,622,923).

To establish a prima facie case for obviousness, the combination of cited references must teach each and every element of the disclosed invention; furthermore, there must be some suggestion or motivation to combine or modify those references. It is the Applicants' position that the combination of *Gossiau* and *Nishimura* fails to teach each and every element of their invention, and in fact, teaches away from their invention; additionally, there is no showing of a suggestion, teaching or motivation to combine said references.

To support their position, Applicants respectfully draw the Examiner's attention to *Gossiau*, page 1, lines 17-30, which state the following:

The transmission of [torsional] oscillations and stresses to the electric machine must be prevented. To this end couplings for drives have

hitherto been provided between the crank shaft [of the engine] and the electric machine shaft. **This arrangement has, however, the drawback that the common shaft of the two units must be divided and that only damping members of limited dimensions can be located in the coupling.**

The object of the present invention is to avoid in radial cylinder internal combustion engine electric generating sets the arrangement of a coupling between the shafts of the internal combustion engine and the electric machine...

Emphasis added. Applicants contend that that the above language from *Goss/au* clearly and unequivocally indicates that *Goss/au* teaches away from the Applicant's invention, as *Goss/au* teaches a non-divided (one piece) shaft where no elastic coupling is involved. Additionally, *Goss/au* does not in any way discuss an arrangement having an elastic coupling connecting the engine and generator shafts and at least one elastic member connecting the engine and generator casings; again, *Goss/au* disparages the use of elastic couplings. Furthermore, *Goss/au* states that the object of his invention is to avoid using an elastic coupling altogether, which is in direct contrast to the Applicants' invention, which incorporates (and claims) an elastic coupling as apart of the arrangement.

Still even further, Applicants point out that *Goss/au* teaches an engine-generator arrangement designed to dampen torsional oscillations (page 1, line 9), wherein the taught *Goss/au* arrangement has a one piece shaft allowing for a greater peripheral shaft length (page 1, lines 40-43) compared to the length available when two separate, but coupled shafts are used. The one piece shaft is taught because the greater peripheral length is needed in *Goss/au* to assure that a sufficient number of dampening members are employed for desired flexibility (page 1, lines 42-46). In contradistinction,

Applicants' disclose an engine-generator arrangement designed to avoid the transmission of omnidirectional vibrations from the engine to the generator, including axial vibrations transmitted from the drive shaft of the engine to the generator. Without an elastic coupling, it is not possible for *Goss/au* to absorb vibrations traveling in the axial direction from the engine to the generator.

With regards to obviousness, the Federal Circuit has affirmed the following:

[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference...would be led in a direction divergent from the path that was taken by the applicant...in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ 2d 1130,1131 (Fed. Cir. 1994).

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination...Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *In re ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed Cir. 1984).

In this instance, it is clear from the above discussion and case law that *Goss/au* teaches away from the Applicants' invention because it diverts one skilled in the art from the path taken by the Applicants (i.e., elastic coupling to connect two separate shafts in conjunction with at least one elastic member to connect the casings and rubber mounted supports, etc.) by openly discouraging and avoiding an arrangement where two separate shafts are connected via an elastic coupling and by avoiding the use of an elastic coupling altogether. *Goss/au* also teaches away from the Applicants' invention in that the line of development flowing from *Goss/au* would not be productive in achieving the result taught by the Applicants, which is to avoid the transmission of omnidirectional vibrations from the engine to the generator, not just torsional oscillations.

Finally, since *Gossiau* is not capable of avoiding the transmission of omnidirectional vibrations, including vibrations transmitted in the axial direction along the shaft, and avoids using an elastic coupling, Applicants submit that there would be no suggestion, teaching or incentive to combine the teachings of *Gossiau* with the teachings of *Nishimura et al.* to achieve the result achieved by the Applicants.

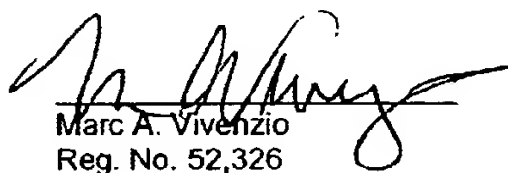
Therefore, with respect to independent claim 5, Applicants respectfully submit that *Gossiau* and *Nishimura et al.* when taken either singularly or in combination fail to teach the Applicants' invention; hence, claim 5 defines patentably over the prior art of record. Withdrawal of this rejection is respectfully requested.

Regarding claims 6, 9-11, 14-17 and 20, Applicants respectfully submit that since these claims depend either directly or indirectly from claim 5, which the Applicants believe is an allowable base claim, it follows that said claims define patentably over the prior art of record. Withdrawal of this rejection is respectfully requested.

CONCLUSION

For all the reasons advanced above, the Applicants respectfully submit that the present application is in condition for allowance. Accordingly, a timely notification of allowance is courteously requested.

Respectfully Submitted,
Lorusso Loud & Kelly

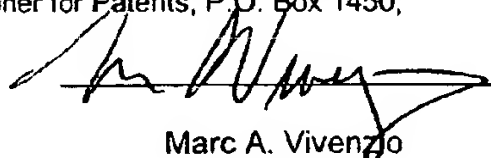

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CERTIFICATE OF MAILING

I hereby certify this response and any paper or document referred to therein as being attached or enclosed, is being deposited on March 12, 2004 with the U.S. Postal Service as First Class Mail under 37 C.F.R. 1.8 in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


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